

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Scott C. Harris

Group Art Unit 2153

Appl. No. : 09/682,853

Filed : October 24, 2001

For : WEB BASED
COMMUNICATION OF
INFORMATION WITH
RECONFIGURABLE FORMAT

Examiner : Y. M. Barqadle

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant's Brief On Appeal

Sir:

Applicant files this Appeal Brief under Rule 41.37, thereby perfecting the notice of appeal that was filed on October 4, 2005. Note that a preappeal conference paper set a new due date of March 13, 2006 for the appeal brief. A one month extension of time is requested.

The present application qualifies for small entity status under 37 C.F.R. § 1.27. Please charge any unpaid fees -- including extension fee --to deposit account 50-1387.

The sections required by Rule 41.37 follow.

Real Party in Interest

The inventor, Scott C. Harris, is the real party in interest.

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Related Appeals and Interferences

There are no known related appeals or interferences.

Status of Claims

Claims 1-23 are pending in the application. Claims 1-3, 5-10, 13, 14, 16-21 and 23 are rejected, and each of these claims are herewith appealed. Claim 4 has been previously canceled, as have claims 11,12, 15 and 22.

Status of Amendments

No amendment was filed subsequent to the close of prosecution.

Summary of Claimed Subject Matter

Claim 1 requires a method which sends a request for information from an interactive device to a first recipient. In the first embodiment, the request for information include placing a bid, and paragraph 25 (page 4) describes sending an e-mail, which forms a request for information.

The e-mail is sent to a "system", which identifies the subject of the e-mail inquiries. The emails are eventually used to query a publicly available source of information, see paragraphs 27 and 28 on page 5. Part of this query process asks the interactive device to identify more information about the specific query, which is described in paragraph 31, with the system returning an e-mail saying "did I understand right that this is what you want to do?". Alternatively, as described in paragraph 31, the system may return a numbered list of the things that can be done. Paragraph 39

contemplates that the user is upping their bid, and in the paragraph 39, the embodiment on page 7, identifies more information about the new bid amount.

In another embodiment, the pager requests status (paragraph 34 on page 6 of the specification). Claim 1 requires sending a request for information from an interactive device to a first recipient. While there are numerous embodiments disclosed, the ones at paragraphs 34 and 36 may be considered representative. At paragraph 34, the pager requests status. Paragraph 35 indicates – “I want to bid on an item that is on my watch list”.

Claim 1 requires sending from the first recipient back to the information device, so that the interactive device can identify more information about the query. Paragraph 36 describes sending back a list of different items that can meet this query.

Once identified, at paragraph 37, the device determines the item to be bid on, see paragraphs 37-39. This is used to query the source of information. See for example paragraphs 40 and 41. The information that is returned to the device, at each level, may be reformatted into a new form, see paragraph 36, which explains parsing the information into a text list, see also other embodiments which describe similar type things. The results are sent in the new form back to the interactive device, see paragraph 36.

Claim 9 defines sending a request for information to a first recipient, which is shown in paragraph 52 on page 10, the fifth and sixth lines at paragraph 52. This is used to query the publicly available source, here, the specified web site, see paragraph 52, second and third lines from the bottom. The results are changed into a different form, pure XML (first line on page 11) and sent to the interactive device. The

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reformatting uses some of the information, see page 11 lines 1 through 5. The reformatting is also done according to a template shown as 433, page 11 lines 1-2.

Claim 17 defines a method which includes receiving a request for information from a publicly available source to be sent, see paragraph 25, page 4, sending a request for more detail about that request (paragraphs 35 and 36) formatting that request into a specified form, where the specified form is the format needed to query. Paragraph 34 shows the request being sent in the specified form and the information being received and reformatting the information into a specified form, see the last five lines of paragraph 34 which explain that the list of information is received, parsed, and reformatted. See also paragraph 36. Claim 21 requires sending a text message from an e-mail pager to an address including text content indicative of what the user wants to carry out on the Internet. See generally, paragraphs 26 and 27. Claim 21 further requires sending a second text message back to the pager. See generally, paragraph 31. Claim 21 further requires translating that text message into an actual operation to be carried out, and carrying out the operation and returning a result. See generally, paragraphs 31-34, which explain this operation.

Issues to be Reviewed on Appeal

The issues to be reviewed on appeal are:

- Are claims 1-3, 5-7, 16-21 and 23 properly rejected under 35 U.S.C. 103 as being obvious over Chen in view of Steele?
- Are claims 8-10, properly rejected as being obvious over Chen in view of Rajan?

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Argument

Claims 1-3, 5-7, 16-21 and 23 stand rejected under 35 USC 103 as allegedly being obvious over Chen in view of Steele. This contention is respectfully traversed for numerous reasons.

Initially, applicant respectfully suggests that the combination itself is based on hindsight. Chen teaches away from requesting additional information, and certainly does not teach any specific way in which additional information could be requested in Chen's disclosed system. Moreover, Chen and Steele are entirely nonanalogous art, and there is no motivation to combine them for the purpose that the official action is attempting to do.

Second, even if the combination were made, the hypothetical combination of Chen in view of Steele still would not render obvious the present claims.

The combination of Chen in view of Steele is an improper combination.

The starting point for making a combination of references under 35 USC 103, is whether the combination would be operatively made by one having ordinary skill in the art. According to M.P.E.P. 2143.01, which cites In re Gordon 221 USPQ 1125 (Fed Cir 1984), any proposed modification of a reference, which renders the prior art unsuitable for its intended purpose, or changes its basic principle, is an improper combination.

1. Chen teaches away from such a combination

Chen does teach a basic system which enables obtaining information from the Internet by sending an e-mail from a handheld device. For example, paragraph 55 explains that the user can issue a command called "quote T" to get a quote for the

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stock price of AT&T. Chen does not have any way of analyzing errors in those commands or ambiguities in those commands. For example, if Chen sends an improper message that said, for example, "quote PX", then Chen does not suggest sending another email to determine how to interpret the erroneous message. In fact, Chen discloses that his mobile device "transforms command aliases" of the request as it is received, see Chen's paragraph 11. In other words, instead of Chen attempting to obtain more information about the command by sending another message (as claimed), Chen attempts to use his information to try to make sense of the command as it is. This is entirely consistent with the rest of Chen's teaching: Chen does the best Chen can do to understand the command as it is, and use it as it is.

Chen's paragraphs 55 and 57 explain more about this: the engine component attempts to recognize the command as it is. This operation, of doing the best you can do with a command that might be ambiguous, is the antithesis of the claimed operation of asking for additional information about the command.

In each of Chen's embodiments, the system can get some information from the user profile. For example, paragraph 76 of Chen explains that when Chen requires additional information, he obtains it from the profile-not by sending a command back to the user. In paragraph 101, when the system needs to know who receives a specified kind of message, it gets it from the profile.

All in all, a reasonable reading of Chen disclosure is that -- when Chen does not have enough information about the request, then Chen either figures that information out based on internal logic and/or the user profile.

The undersigned agrees, as the Patent Office has urged in many of the official actions, that Chen could be modified to request information. Of course, it would be

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possible to modify Chen to request additional information about a query. The proper question for the obviousness rejection, however, is not "what is possible", as the rejections have urged. Under current law, the question is rather, "what is obvious" based on Chen -- not what is POSSIBLE based on Chen.

Here, modifying Chen in this way would contradict Chen's teaching, or at the very least, would not be suggested by Chen's teaching. While the modification would be physically POSSIBLE, it is not taught or suggested by Chen -- and in fact Chen teaches that something very different actually happens.

Any attempt to modify Chen to operate like the present claims would go against Chen's teaching of how to interpret incomplete results. This would change the basic principle of operation of Chen. Hence, this is the first reason why the combination is improper. Under M.P.E.P. 2143, one having ordinary skill in the art would not combine Chen with Steele, or Chen with any other reference that showed obtaining additional information by sending another message.

2. Chen and Steele are non-analogous art.

Moreover, it is respectfully suggested that Chen and Steele are entirely non-analogous art for the purpose for which they were combined. The rejection attempts to combine Steele's teaching from areas around its paragraph 129. This paragraph, however, relates to the way that the fields in an advertisement, e.g. of an automobile for sale, is obtained for use on Steele's multimedia entertainment system. Steele uses location based advertising on his radio/TV/AM/FM. For example, an auto for sale could be advertised in a certain geographic area. The advertisement is formed by asking the user for information to populate certain fields in a form.

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The current rejection proposes combining Steele's advertisement form for the purpose of modifying Chen. However, with all due respect, these are completely non-analogous technologies.

Chen is attempting to obtain information using a handheld device from the Internet. If Chen had a complete terminal, such as is presumably available in Steele, then the compact notation described by Chen would be wholly unnecessary. Moreover, one having ordinary skill in the art would not find any usable teaching about how an advertisement obtaining system could be used with a system that obtains information over the Internet. Determination of how to obtain advertisement content and populate an advertising form, is entirely non-analogous relative to Chen's teaching of how to use a mobile device to query the Internet.

Therefore, for this second reason, one having ordinary skill in the art would not be motivated to make the hypothetical combination of Chen in view of Steele.

Even if the hypothetical combination of Chen in view of Steele were made, it still would not teach or suggest the claimed subject matter.

Steele teaches a multimedia system, which as part of the system, includes advertisements. The user can request and receive additional information about the advertised product. For example, the user could request information using an info button, such as 172 described in paragraph 56 of Steele. This causes the advertising database to provide information about the database being run, see paragraph 63. The user can also request buying information.

Paragraph 129 describes forming an advertisement. The system determines if the ad being obtained is an existing or custom ad. If it is a custom ad, the ad may need

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to have some additional information. Paragraph 131 describes that the vendor may respond and request additional details for the ad -- such as the mileage, temperature or gauge information related to the ad.

However, this is not information about the query itself, and is not requesting clarification of the query. Steele requests additional information for the content of the specific advertisement which will be posted. Therefore, nothing in Steele teaches or suggests asking for more information relative to a query to a publicly available database, where the system that is doing the querying requests more information about the query.

Rather than a query to a publicly available database, Steele teaches how to populate the fields in an advertisement that is going to be posted. This is very different than the claimed subject matter, which is querying a publicly available source of information.

Therefore, Chen in view of Steele, even if the combination could be operatively made, is entirely different than claim 1. Claim 1 defines a request for information sent from an interactive device to a first recipient, and the first recipient requests the information device to identify more information about the query. Note the specific words of the claim, however, require the interactive device to "identify more information about a specific query to be made to said request to query a publicly accessible source of information". Claim 1 also requires that the first recipient subsequently uses that information to query a publicly accessible source of information. However, Steele teaches that the requests are made to populate fields in the context of an advertisement being placed. Therefore, in Steele, information is obtained to populate the fields in an advertisement. Steele's advertisement is not a "query" as claimed.

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Steele's advertisement is not a request for information sent from an interactive device to a final recipient, as claimed. Rather, Steele's advertisement has a number of fields, which once populated, can be sent over a channel. This is not a query to a publicly available database, as claimed. Steele teaches nothing about modifying a query to a database of the type claimed.

To summarize, while Steele does request additional information, it is not "information about a specific query to be made." It rather is information about fields to be populated within an advertisement. An advertisement is not a specific query to be made of a publicly of accessible source of information. A query to a source of information requests that the source of information returns some kind of answer. In contrast, an advertisement is which is sent to a number of users does not request an answer to a specific question. The two are entirely different.

Therefore, a hypothetical combination of Chen with Steele would produce a Chen type system with a Steele type system that may allow requesting additional information about fields in an advertisement to be posted. This is entirely different than the present claims, which request additional information about a query to be sent to a publicly available sent source of information.

Claim 1 should be allowable for these reasons.

Now addressing the response to arguments in the final rejection of May 6, 2005, with all due respect, the Patent Office is confusing the difference between obvious to combine, and possible to combine. Item 2 contradicts Applicant's statement that it would not be obvious to combine Chen with Steele because Chen teaches away from requesting additional information. The examiner contends that nothing "precludes" Chen from requesting additional information. With all due respect, this standard used

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by the rejection is legally incorrect. This standard should be the one set forth by the Federal Circuit and other courts. The rejection's proposed standard is "Does Chen's system preclude the alteration?". This is not, and has never been the law.

A reference must fairly suggest the combination. The statements that Chen's system is flexible and "would be perfectly OK to combine with other references" (quoting from the Official Action) is legally irrelevant. The point is that there must be suggestion and motivation in the references, and the combination cannot contradict the teaching in either of the references.

The statement in the rejection that Steele queries a publicly available source of information with the updated data is simply incorrect. This conclusion is not from Steele's teaching, but is rather from the PRESENT teaching. Steele simply populates fields in a database. Steele requests more information to populate a database, not for a query.

Claim 1 should therefore be allowable for these reasons, along with the claims that depend therefrom.

Claim 17 should be allowable for analogous reasons to those discussed above. Claim 17 specifies receiving a request from a publicly available source of information, sending a request to the client for more detail about that request. As described above, the hypothetical combination of Chen in view of Steele: 1) would not be operatively made by one having ordinary skill in the art, and 2) even if made, would simply teach a Chen type system with Steele's system of determining additional information about the advertisement about populating fields in the advertisement. Therefore, claim 17 is allowable along with the claims that depend therefrom.

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Claim 21 specifies sending a text message from an e-mail pager to a specified address. That includes text content including an action that the user wants to carry out, second sending back a text message, and after that carrying out the operation. As described in detail above, Chen in view of Steele would not be operatively combined by one of ordinary skill in the art. Even if combined, this would simply teach a Chen type system with a Steele system of requesting more information to populate fields in an advertisement. Therefore, claim 21 is even further allowable.

Claim 23 should be additionally allowable on its own merits, since it specifies that the second sending is a request for confirmation of contents. Nothing in Steele suggests a confirmation of contents: Steele only suggests asking for information to populate fields in a database. Claim 23 should hence be allowable for these reasons.

Claims 8-10 stand rejected over Chen in view of Rajan. Initially, this rejection of claim 8 is facially defective. The Patent Office has already admitted, elsewhere in this rejection, that Chen does not teach or suggest the claimed operation of sending an additional request to obtain more information. Claim 8 depends from claim 1, hence the subject matter of claim 1 is part of claim 8. Hence the rejection of claim 8 is facially defective: the rejection of claim 8 does not include the Steele reference, and therefore does not even attempt to render obvious sending back additional information to identify, as included in the claim 8 combination.

For claims 9 and 10, Rajan teaches real-time monitoring and notification of data updates for web-based synchronization. Rajan admittedly teaches that it can be used to obtain bank statements. The user may configure the system to be notified when the bank balance falls below a certain amount for example. However, Rajan has no teaching or suggestion of how a user could request information, from their pager, about

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a bank balance. Rajan teaches that there can be a notification to the pager about certain things in their bank, but teaches nothing about a query being formed from the pager itself.

Therefore, the rejection of claim 8 is facially faulty. Claims 9 and 10 should be allowable for the reasons above. Claim 9 defines sending information back and reformatting it according to a prestored template. Rajan does teach that information can be formatted between templates. The templates described by Rajan are scripted templates using "known site logic" to enable navigation. There is no teaching or suggestion of reformatting information according to a template for an interactive device, as claimed. Therefore, claim 9 should be allowable for these reasons.

Claim 10 specifies that the reformatting places the information into XML form. Rajan certainly does teach XML could be used, but it teaches nothing about reformatting into XML: it only teaches that information can be received initially in XML.

For all of the reasons given above, applicants respectfully suggest that all of the claims should be in condition for allowance. Reversal of the current legally incorrect position is respectfully requested.

Please charge any unpaid fees due in connection with this response to Deposit Account No. 50-1387.

Respectfully submitted,

Date: ____April 3, 2006

_____/SCH/_____
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CLAIMS APPENDIX

1. A method, comprising:
 - sending a request for information from an interactive device to a first recipient;
 - sending a request from said first recipient to said interactive device, requesting said interactive device to identify more information about a specific query to be made to said request to query a publicly accessible source of information;
 - at said first recipient, using information from said request to query a publicly accessible source of information;
 - receiving results from querying said source of information;
 - reformatting said results into a new form; and
 - sending said results in said new form to said interactive device.
2. A method as in claim 1, wherein said reformatting said information comprises assembling a message which includes some, but not all, of the information received from said publicly accessible source of information.
3. A method as in claim 1, wherein said reformatting comprises reformatting said information into a text message.
5. A method as in claim 2, wherein said interactive device also stores personal information associated with a user of the interactive device, and wherein said sending comprises sending a request for information which includes some of said personal information.

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6. A method as in claim 5, wherein said personal information which is sent includes logon information and a password.

7. A method as in claim 6, further comprising signifying to said source of information an indication to purchase a product.

8. A method as in claim 5, wherein said source of information indicates a user's bank balance.

9. A method, comprising:
sending a request for information from an interactive device to a first recipient;
at said first recipient, using information from said request to query a publicly accessible source of information;
receiving results from querying said source of information;
reformatting said results into a new form;
sending said results in said new form to said interactive device;
wherein said reformatting said information comprises assembling a message which includes some, but not all, of the information received from said publicly accessible source of information; and
wherein said reformatting comprises reformatting said information according to a prestored template.

10. A method as in claim 9, wherein said reformatting comprises reformatting said information into an XML form.

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13. A system as in claim 9, wherein said reformatting comprises changing said HTML response into another format.

14. A system as in claim 13, wherein said another format is a text format.

16. A system as in claim 11, wherein said processor also receives personal identification information, and uses said personal identification information to form said request, including logon information.

17. A method, comprising:

- receiving a request from a first client for information from a publicly available source of information that requires information to be sent to the publicly available source of information in a specified form;
- sending a request to said first client for more detail about said request;
- formatting the request from the first client into the specified form;
- sending the request in the specified form to the publicly available source of information, and receiving the information therefrom; and
- reformatting the information and sending the reformatted information to the first client.

18. A method as in claim 17, wherein said request from said first client includes personal logon information, and said specified form includes said logon information including at least a user login name and a password.

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19. A method as in claim 17, wherein said reformatting comprises reformatting the information into an XML format.

20. A method as in claim 17, wherein said reformatting the information comprises reformatting the information into a text format.

21. A method, comprising:
sending a text message, from an e-mail pager, to a specified address, said text message including text content indicating an action that the user wants to carry out on the Internet;
second sending a text message back to said email pager; and
after said second sending, at a computer associated with said specified address, translating said text message into an actual operation to be carried out on the Internet, and carrying out said operation on the Internet, and returning a result from said operation on the Internet to said e-mail pager.

23. A method as in claim 21, wherein said second sending is a request for confirmation of contents of said action.

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EVIDENCE APPENDIX.

None

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RELATED APPEALS APPENDIX

None